

Remarks

submitted March 2008

[001] This is in response to the Office Action dated 25 Feb 2008.

[002] Amendments

[None at this time.]

[003] Comment re section 9 (page 4) of the O/A and re section 11 (page 5) of the O/A

Section 9 of the O/A includes:

.. claim 1 is not considered to be patentable and considered to be subject to a rejection on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of US-6,887,046.

Section 11 of the O/A includes:

As the application stands currently, claims 5, and 13-18 would be rejected under non-statutory obviousness double patenting in any subsequent office action on the merits.

As we understand it, from this wording, the PTO is not actually making any double-patenting rejections in this O/A -- neither statutory nor non-statutory.

We note that the last O/A (issued 01-jun-2007) included a double-patenting rejection. We would prefer that, if the PTO feels it has a legitimate basis for a double patenting rejection of claims 1,5,13-18, the PTO should have made that specific rejection in this present O/A, setting out reasoned explanations as to proper legal basis. We would prefer it if the PTO did not threaten to make rejections in some future O/A.

Furthermore, given that the above-quoted statements do not amount to actual rejections of the claims, the applicant is left to wonder just what is the PTO's purpose in making the statements. The PTO has a duty to express its positions clearly. The PTO has a duty not to leave the applicant in doubt as to the actuality of, and the basis for, each rejection.

Thus, the examiners have not properly expressed the PTO position, in the present O/A, and we feel the O/A must be withdrawn, simply for that reason.

[004] Further comments re section 11 (page 5) of the O/A

A number of questions are raised by the contents of section 11, under the heading "Response to Arguments". Consider the following:

.. applicant has moved a section of the limitations stated in claim 1 (col 21 ll 43-48) of US 6,887,046 into a dependent claim in the instance application with claim 3. Thus the applicant has effectively set forth limitations that are broader than the limitations of the "Foreign" application of which it claims priority under 35 USC 371 .

We do not accept the PTO's comments about "moving" sections of limitations. We cannot see any purpose to, or result from, the PTO's remarks in this regard. The PTO's remarks seem to relate to double-patenting, but no double-patenting rejection has been made.

Of course, we know that 35.USC.101 requires that the scope of claim 1 in this present application must be different from the scope of claim 1 as granted in US-6,887,046. But 35.USC.101 only requires that the claims in different patents must be different in scope. There is nothing in 35.USC.101 to suggest that that difference cannot lie in a broadening of the claims.

Section 11 of the O/A continues: .. For this reason it was determined that claims 5,13,18,32 were subject to statutory double patenting under 35 USC 101 .

It seems the PTO has construed 35.USC.101 to such effect that, where a claim in a US patent application is broader than the limitations of the "Foreign" application from which it claims priority, that fact is enough to justify a statutory double-patenting rejection. If the PTO is indeed arguing that that is the degree of justification required for a double-patenting rejection, the PTO is, with respect, mistaken. Again, however, the O/A does not actually set out a double-patenting rejection.

[005] Further comment re section 11 (page 5) of the O/A

Section 11 of the O/A then states:

.. examiner agrees that claim 1 of US 6,887,046 does not claim the limitations of the instant application . .

-- The examiner is correct. But then, the O/A appears to contradict itself, by alleging that claim 1 of US 6,887,046 claims **substantially the same invention** as claim 1 of this present application.

Again, we cannot understand just what is the PTO's position. It seems as

though the PTO is trying to establish some kind of legal/factual basis for a double-patenting rejection. So the applicant is left with substantial doubts and questions, because the O/A does not actually express a double-patenting rejection.

[006] As regards any future double-patenting rejection, we feel such a rejection would be incorrect. The present claims in this application are quite clearly patentably distinct from the claims recited in US-6,887,046.

We do not, of course, ask the PTO examiners to refrain from making allegations of double-patenting, in the future, if they deem such allegations to be proper. We do however regret that such allegations, if any are forthcoming, could not have been dealt with already, in the prompt and proper manner that is in the best traditions of the PTO.

[007] Election/Restrictions

During the national phase, in USA, of a PCT international patent application, the US PTO is forbidden, under PCT Art 27(1), from requiring compliance with requirements relating to the contents of the international application different from or additional to those provided in the PCT.

In this case, the PCT authorities, during the international phase, examined the international application for lack of unity, and the PCT authorities determined that there is no lack of unity as between what the US PTO is now referring to as Group I (claims 1-30) and Group II (Claim 31). Therefore, the US PTO (like the POs of all the other elected or designated countries) is now barred from imposing further or unilateral lack-of-unity objections.

We take it the PTO examiners have simply made a mistake here. If the PTO were to decide to continue the Restriction requirement as between the two Groups of claims, we would ask to be informed as to how/why the PTO is empowered to bypass or ignore PCT Art.27(1).

[008] Traversal of Requirement for Election of Species

We traverse the requirement for election of species on the ground that PCT Art 27(1) prohibits the PTO from imposing such requirement.

Under the PCT, claims are in unity if they are so linked as to form a

single general inventive concept. It is well settled that, under the PCT, where a plurality of claims are sub-claims that depend all from the same independent claim, those plural sub-claims are, by definition, in unity with each other, and with the independent claim from which they all depend. There is nothing in the PCT to the effect that *sub-claims*, i.e. claims that share dependency from another claim, could even possibly lack unity, either with each other, or with the independent claim from which they all depend. Under the PCT, it is only possible for independent claims to be out-of-unity with each other.

The US concept of *election of species* has no equivalent in the PCT. The US *election of species* concept does envisage that even sub-claims that share dependency might be subject to a mutual restriction requirement. The *election of species* concept does envisage sub-claims being out of unity with each other, even though those sub-claims all depend from the same independent claim. But *election of species* is a special US provision, not found in other countries, and not found in the PCT.

We take it the PTO examiners have simply made a mistake here. PCT Article 27(1) prohibits the US PTO from imposing *election of species* requirements in PCT-derived patent applications. If the PTO were to decide to continue the requirement for election of species, we would ask to be informed as to how/why the PTO is empowered to bypass or ignore PCT Art.27(1) in this case.

[009] Requirement to elect a single species

Even though the PCT forbids the USPTO from imposing the requirement for election of species, nevertheless the PTO has imposed it. The O/A emphasises that our reply would be held non-responsive if we did not actually elect one of the species. Accordingly, we elect the species that is the apparatus depicted in Figs.1,2,3,4a,4b-4f of our specification.

The O/A designates the embodiment depicted in figure 4 as being species 1-C. However, the present application does not contain a figure 4, as such. We feel the examiners have simply made a mistake here. **We are proceeding on the basis that, when they refer to "The embodiment of figure 4" as being the Species 1-C, the examiners intended to refer to "the apparatus depicted in Figs.1,2,3,4a,4b-4f" as being the Species 1-C.**

Accordingly, we require the PTO to examine all the claims in the application that read onto the elected apparatus as depicted in

Figs.1,2,3,4a,4b-4f.

[0010] Claims that read onto the elected species

The O/A identifies the claims that read onto Species 1-C as being claims 1,9,10. We disagree with the PTO's assessment that *only* claims 1,9,10 read onto Species 1-C.

We can find no limitations in any of the following claims, by which the claim might be regarded as being *distinguished* from the elected apparatus (i.e from the apparatus depicted in Figs.1,2,3,4a,4b-4f). We are referring here to **claims 1-3,5-15,22,25,29-31**. We feel that all these claims must be examined, because they all read onto the elected apparatus.

If the PTO were to decline to examine any one of our claims 1-3,5-15,22,25,29-31 on the grounds that such claim does not read onto the elected apparatus, we would request to be provided with a careful explanation as to just what limitation the PTO has found, in that claim, which distinguishes that claim from the elected apparatus. Again, it is our view that none of the claims listed above contain any such limitations.

[0011] Allowability of claim 1.

Although there is no rejection under 35.USC.103 in the O/A, the O/A hints that such rejection might be forthcoming, based on US-2002/0187061 (Arnold, published 12-Dec-2002), in some future O/A.

If the PTO were to actually make a rejection of claim 1 based on Arnold, we would request that the examiners:

- (a) clearly identify the place in the prior art where there is depicted the old, unmodified, "start" apparatus, i.e the apparatus that is to be the subject of the allegedly-obvious modification the PTO examiners have in mind;
- (b) describe the structure of the new apparatus the PTO examiners have in mind, which incorporates the PTO's allegedly-obvious modification, and to describe that new apparatus in enough detail to enable a skilled designer of engine coolant systems to determine whether the new apparatus does or does not fall within the scope of the rejected claim;
- (c) provide a carefully-detailed explanation as to the prior art teaching by which the skilled designer of engine coolant pumping systems would

be led to make the allegedly-obvious modification.

Under (c), we would be looking, in particular, for a carefully reasoned explanation as to how/why the skilled designer would be encouraged, following a perusal of Arnold, towards so modifying this or that old apparatus as to arrive at some new apparatus that might be regarded as falling within the scope of claim 1.

We might accept that Arnold has swirl-vanes and a vane-orientation-guide. However, there is nothing in Arnold, as we can see, that is equivalent to our rad-port-thermal-unit, nor to our swirl-vane-thermal-unit. Also, we note that Arnold deliberately designed the vanes NOT to close, i.e not to completely close. Thus, we would be inclined to the view that it is not possible for *anything*, in Arnold, to be regarded as being equivalent to our radiator-port-closer.

In short: there is no teaching, in Arnold, of any notion of placing a radiator-port, and a thermally-operated radiator-port-closer, together with the swirl-vanes, inside the pumping-chamber.

We might question why Arnold has even been mentioned. Arnold is simply another example of the well-known use of variable-orientation guide-vanes to control flow through the blades of a rotary impeller. Arnold even relates to airflow, not to our liquid-flow. The idea of placing a set of variable-geometry swirl-vanes in the same housing as an impeller, to control water flowrate through the impeller, has been around for many years -- as shown, for example, in US-2,306,742 (Moody, 1942), that we mentioned in our specification.

We note, again with respect, that it is not in the best traditions of the USPTO for the PTO examiners to threaten to make rejections in some future O/A.

[0012] In our view, this application is in order for allowance, and we look forward to being notified to that effect.

Submitted by:

/Anthony Asquith/
Anthony Asquith
Regn 32373
Agent for the Applicant

Enclo: (none)